

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001**REMARKS**

Prior to entry of this Amendment:

- Claims 1-76 were pending in the present application
- Claims 1-11, 38-42, and 51-55 stand rejected
- Claims 12-37, 43-50, and 56-76 have been withdrawn

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-76 will be pending
- Claim 1 will be amended
- Claims 1, 38, and 51 are the only independent claims

A. Section 101 Rejection

Claims 1-11 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. [Office Action, pages 4-5].

The proper legal standard for statutory subject matter was not applied to the rejected claims. In fact, applying the proper legal standard demonstrates that all claims are directed to statutory subject matter.

As best as we understand the rejection of the claims for being directed to non-statutory subject matter, the basis for that rejection is any or all of the following: A claim must "necessarily involve a computer." [Office Action, page 5].

To the extent the rejection under Section 101 applies a novel standard (a "computer" must necessarily be "involved") that requires additional criteria or otherwise departs from the requisite legal analysis under Section 101, the rejection is flawed. We incorporate our previous remarks with respect to the only current test for statutory subject matter. [Response filed August 18, 2004, pp. 21-22]. We maintain that the pending claims meet the only standard for statutory subject matter by producing a useful, concrete, and tangible result. The Examiner does not assert that any claim fails to produce a useful, concrete, and tangible result.

In addition, we traverse the Examiner's assertion that any claim must "necessarily involve a computer" to be statutory subject matter. There is no legal basis for this assertion; the Examiner does not assert otherwise. Even if there is a "technological arts" requirement (which we dispute), we submit that a claim need

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

not recite a "computer" in order to be "within the technological arts" or that only a "computer" is a "non-trivial" use of "technology." The Examiner has not cited any statutory, regulatory or precedential case law basis for any such assertion.

Nevertheless, solely to expedite allowance of the pending claims, we have amended independent Claim 1 to recite that information is received *via an electronic communication network*. We respectfully submit that Claims 1-11 are statutory subject matter under §101. We expressly reserve the right to pursue the subject matter of Claims 1 – 11 as pending before this amendment in a continuing application.

We respectfully note that contrary to the Examiner's novel requirement, we have not included the word "computer" in Claim 1. We respectfully submit that some types of *electronic communication networks*, as that term would be properly construed, may not necessarily involve a "computer."

B. Section 103(a) Rejection

All of the pending claims (Claims 1-11, 38-42, and 51-55) stand rejected under 35 U.S.C. 103(a) as being unpatentable over:

(i) Robert Bruss, "No grey area: selling a site twice is illegal," Chicago Tribune (December 2, 1995) (hereinafter "Bruss"); and

(ii) the Examiner's "Official Notice" of subject matter that is allegedly "notoriously well known" or "commonly found" yet is unsupported by any evidence of record.

We traverse the Examiner's § 103 rejections. The Examiner cannot have established a *prima facie* case of obviousness of any claim where the Examiner depends explicitly on asserted subject matter that the Examiner admits is not supported by any evidence of record.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet, 149 F.3d

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

1350, 1355 (Fed. Cir. 1998). The secondary considerations are also essential components of the obviousness determination. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the prima facie burden only by showing some objective teaching leading to the purported combination of references. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Lacking a motivation to combine references, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000). The "PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

Mere administrative or judicial notice of what existed in the prior art is not permitted. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

A reference must be provided to show the scope and content of the prior art. See, e.g., In re Eynde, 480 F.2d 1364, 1370 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men, and are not amenable to the taking of such notice.").

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

To reject claims in an application under Section 103, an examiner must show an un rebutted prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a prima facie case of obviousness is upon the examiner. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993); Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Substantial evidence is thus required to establish a *prima facie* case of obviousness. Substantial evidence is "such relevant evidence from the record taken as a whole as might be accepted by a reasonable mind as adequate to support the finding under review." Texas Instruments v. Cypress, 90 F.3d 1558, 1563 (Fed. Cir. 1996).

The reviewable findings include any finding that all of the features of every claim were well known and any finding that there was a known motivation to provide for all of the features of every claim. The evidence of record does not include anything that might be accepted by a reasonable mind as adequate to support such findings. The Examiner (i) has not provided evidence that all of the features of any claim were known and (ii) has not provided any evidence of a motivation to provide for all the features of any claim. The Examiner relies instead on convenient but unsupported assumptions as to what was allegedly known at the time of invention.

The record taken as a whole does not include any evidence supporting any of the following assertions by the Examiner:

(i) "that there is a determining to accept an offer based on the received information"; or

(ii) that "it was notoriously well known in the art at the time of the invention to record information concerning a real estate sale in public records or the Multiple listing service (MLS)"; or

(iii) that "[t]he remaining features of the instant claims are all features, which are commonly found within a real estate transaction"; or

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

(iv) a motivation to “assure that the best price is being negotiated in favor of the person wishing to sell the property” that would suggest to “determine the acceptance of a subsequent offer, based on the most current information”; or

(v) what features “are required to conclude a real estate transaction involving an assignable contract”; or

(vi) a motivation to modify Bruss to provide for all of the alleged features “required to conclude a real estate transaction involving an assignable contract.”

Bruss does not support any of the above assertions; the Examiner does not assert otherwise. Accordingly, there is no relevant evidence of record as might be accepted by a reasonable mind as adequate to support any of the Examiner’s § 103 rejections.

Although Bruss mentions the term “assignable contracts,” it does not suggest what “features” are “required to conclude a real estate transaction involving an assignable contract.” To the contrary, Bruss warns that real estate laws “differ from place to place.”

In addition, we submit that Bruss does not provide substantial evidence of the subject matter for which it is asserted. The Examiner relies on Bruss only as allegedly teaching the features of:

*arranging for a customer to redeem a product from a third party
receiving, via a communication network, information relating to a
redemption, of the product and by the customer, that has occurred*

Bruss does not appear to teach any such features. The Examiner refers only to “page 2,” which includes brief discussions of three different questions posed to the article’s author. We request clarification as to how the Examiner is interpreting the language of those features and how the Examiner is interpreting Bruss (i.e., which particular Q&A scenario(s) the Examiner is relying on) as teaching the meaning ascribed by the Examiner to those features.

Bruss does not appear to suggest that (i) a redemption of a product by a customer (ii) has occurred, much less (iii) receiving information relating to such a redemption (iv) via a communication network.

The Examiner’s rejection of all claims is thus based in part on unsupported general assertions of what allegedly known before the time of our invention. We respectfully traverse the Examiner’s Official Notice of the recited features of all of the claims.

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

We note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The cited Bruss reference does not support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner's assertions as to what was well or commonly known. The Examiner notes all of the resources available that must be searched for the pending claims:

The examiner notes that a search within 705/26 subclass is not limited to just that sub class, but requires a search of the all [sic] US patents, PG PUBs, IBM articles, Derwent and foreign patents found in the USPTO database. Also included, is a search of non-patent literature, which may include the Internet and databases such as Proquest and dialog.

Despite the numerous sources available, the Examiner was unable to identify any reference disclosing subject matter the Examiner alleges is "notoriously well known" or "commonly found."

Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, we cannot properly determine the bounds of the prior art. Accordingly, we dispute that the subject matter asserted was known at the time the invention was made, and request, for each feature of each of the claims a reference to clarify the subject matter in more detail. MPEP 2144.03.

In other words, Official Notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and are **not amenable to the taking of judicial or administrative notice.**") (emphasis added); In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always construe [the rule permitting judicial notice] **narrowly** and will regard facts found in such manner with an eye toward

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

For at least the reasons stated herein, we respectfully request allowance of Claims 1-11, 38-42, and 51-55.

PATENT

Application No.: 09/605818
Attorney Docket No.: 00-001

C. Authorization to Charge Appropriate Fees & Petition for Extension of Time to Respond

We do not believe that any fees are necessary for this response.

Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:

Deposit Account: 50-0271

Order No.: 00-001

Please credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.


D. Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

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Date

Respectfully submitted,



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